

**REMARKS**

Applicant thanks the Examiner for the courtesy of a personal interview on 8 July 2004. Applicant also thanks the Examiner for the indication that claims 4-6, 12-13 and 18 define patentable subject matter and would be allowable if rewritten in independent form, including all limitations of the base claim and any intervening claims from which they depend.

By this Amendment, Applicant amends claims 1, 3, 4, 9, 10, 12 and 18, cancels claim 17, and adds new claims 19-20.

Accordingly, claims 1-16 and 18-20 remain pending in the application.

**REQUEST FOR NEW OFFICE ACTION**

The Office Action Summary states that claim 14 is rejected. However, the Office Action fails to state any basis whatsoever for the rejection of claim 14.

Accordingly, Applicant respectfully requests that claim 14 be allowed, or else if a rejection of claim 14 is to be maintained, Applicant respectfully requests a new, non-final, Office Action which states a basis for the rejection of claim 14.

**35 U.S.C. § 102 and 103**

The Office Action rejects claims 9 and 17 under 35 U.S.C. § 102 over Brimberg U.S. Patent 4,652,239 (“Brimberg”); claims 1-3 and 10-11 under 35 U.S.C. § 103 over Brimberg; and claims 7-8 and 15-16 under 35 U.S.C. § 103 over Brimberg in view of Kamm U.S. Patent 3,785,065 (“Kamm”).

Applicant respectfully submits that all of the claims 1-3, 7-11, and 15-16 are patentable over the cited art for at least the following reasons.

**Claim 1**

Among other things, the process of claim 1 includes communicating from a first party to a second party a survey of the real property, a photograph of the real property, and a list of desired landscape characteristics for the real property.

At the outset, Brimberg never discloses or suggests communicating anything

from a first party to a second party. More specifically, Brimberg never discloses or suggests communicating a survey of real property, a photograph of the real property, and a list of desired landscape characteristics for the real property. Indeed, Brimberg does not even disclose any list of desired landscape characteristics for the real property, and specifically does not disclose this in the cited text at col. 5, lines 14-30. So, claim 1 is deemed patentable over Brimberg for at least this reason.

Furthermore, Brimberg never discloses or suggests use of any photograph of a property in a process of generating a landscape plan.

The Office Action fairly admits that Brimberg does not disclose use of any photograph of a property in a process of generating a landscape plan. However, the Office Action states that it would be obvious to modify Brimberg to replace Brimberg's "sheet of drafting" with a photograph.

Applicant respectfully traverses the proposed modification of Brimberg as lacking any suggestion or motivation in the prior art, and as rendering Brimberg unsatisfactory with its intended purpose.

MPEP § 2143 provides that:

"Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art."

The motive suggested by the Office Action for modifying Brimberg is apparently a hindsight rationale for a modification not found anywhere in the prior art. The Office Action does not point to anywhere in the cited references with this motive is given, nor did the Examiner submit an affidavit as required by 37 CFR 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see MPEP § 2144.03). The applicant requests such an affidavit if this rejection continues to be

maintained based a motive for modification not explicitly suggested in the prior art.

Additionally, M.P.E.P. § 2143.01 provides that:

“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

Here, Brimberg teaches that a sketch of an existing space is made of a sheet of paper, such that the dimensions between elements can be indicated and the sketch can be transferred to a special polyester worksheet with grid lines such that symbol elements can be electrostatically adhered thereto. Meanwhile, if the sketch was replaced by an actual photograph of the property, as proposed in the Office Action, the dimensional information would not exist, and it would be unsuitable for transfer to the grid-lined polyester worksheet as disclosed by Brimberg. Therefore, Applicant respectfully submits that the proposed modification would change the principle of operation of Brimberg’s reference, and the modification is therefore improper.

Finally, MPEP § 2143.01 also provides that:

“The claimed combination cannot render the reference inoperable for its intended purpose.”

As noted above, if Brimberg’s sketch was replaced by an actual photograph of the property, as proposed in the Office Action, the dimensional information would not exist, and it would be unsuitable for transfer to the grid-lined polyester worksheet as disclosed by Brimberg. So, it would not be possible to produce a space plan, which is Brimberg’s intended purpose. Therefore, Applicant respectfully submits that the proposed modification is improper.

Accordingly, for at least these reasons, Applicant respectfully submits that

claim 1 is patentable over Brimberg.

Claim 2

Claim 2 depends from claim 1 and is deemed patentable for at least the reasons set forth above with respect to claim 1, and for the following additional reasons.

Among other things, in the process of claim 2 the generic plant categories are defined according to a plant size.

The Office Action fairly admits that Brimberg fails to disclose such a feature, but it would be obvious to modify Brimberg to define generic plant categories according to a plant size.

Applicant respectfully traverses the proposed modification of Brimberg as lacking any suggestion or motivation in the prior art.

MPEP § 2143 provides that:

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.”

The motive suggested by the Office Action for modifying Brimberg is apparently a hindsight rationale for a modification not found anywhere in the prior art. The Office Action does not point to anywhere in the cited references with this motive is given, nor did the Examiner submit an affidavit as required by 37 CFR 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see MPEP § 2144.03). The applicant requests such an affidavit if this rejection continues to be maintained based a motive for modification not explicitly suggested in the prior art.

Accordingly, for at least this additional reason, Applicant respectfully submits that claim 2 is patentable over Brimberg.

Claim 3

**Claim 3 has been rewritten in independent form without any change of scope whatsoever.**

Among other things, the process of claim 3 includes defining generic plant categories according to a plant size and a leaf texture.

The Office Action fairly admits that Brimberg fails to disclose such a feature, but it would be obvious to modify Brimberg to define generic plant categories according to a plant size and a leaf texture.

Applicant respectfully traverses the proposed modification of Brimberg as lacking any suggestion or motivation in the prior art.

MPEP § 2143 provides that:

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.”

The motive suggested by the Office Action for modifying Brimberg is apparently a hindsight rationale for a modification not found anywhere in the prior art. The Office Action does not point to anywhere in the cited references with this motive is given, nor did the Examiner submit an affidavit as required by 37 CFR 1.104(d)(2) if this proposed motive were based on facts within his personal knowledge (see MPEP § 2144.03). The applicant requests such an affidavit if this rejection continues to be maintained based a motive for modification not explicitly suggested in the prior art.

Accordingly, for at least this additional reason, Applicant respectfully submits that claim 3 is patentable over Brimberg.

Claims 7-8

Claims 7-8 depend from claim 1. Applicant respectfully submits that Kamm

does not remedy the shortcomings of Brimberg as explained above with respect to claim 1. Therefore, claims 7-8 are deemed to be patentable for at least the reasons set forth above with respect to claim 1, and for the following additional reasons.

Among other things, the process of claim 8 includes providing a list of specific plants belonging to each generic plant category.

Neither Brimberg nor Kamm discloses or suggests such a feature, and accordingly no possible combination of Brimberg and Kamm could produce the process of claim 8 that includes such a feature. Indeed, the Office Action fails to even mention this feature, or to allege that it is disclosed by either Brimberg or Kamm.

Accordingly, withdrawal of the rejection of claim 8 is respectfully suggested.

#### Claim 9

Among other things, the method of claim 9 includes (1) defining a set of generic plant categories according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen; and (2) assigning a set of symbols to the generic plant categories.

Applicant respectfully submits that the prior art, taken individually or collectively, does not disclose or suggest any process including such features.

Accordingly, for at least these additional reasons, Applicant respectfully submits that claim 9 is patentable.

#### Claims 10-11

Claims 10-11 depend from 9 and are deemed patentable for at least the reasons set forth above with respect to claim 9, and for the following additional reasons.

In the process of claim 10, the generic plant categories are defined according to at least one of a plant height and a plant width, while in the process of claim 11, the generic plant categories are defined according to a leaf texture.

The Office Action fairly admits that Brimberg fails to disclose such features, but it would be obvious to modify Brimberg to include such features.

For similar reasons to those set forth above with respect to claims 2 and 3, Applicant respectfully traverses the proposed modification of Brimberg as lacking any

suggestion or motivation in the prior art, and as being unsupported by any affidavit of personal knowledge.

Accordingly, for at least these additional reasons, Applicant respectfully submits that claims 10-11 are patentable over Brimberg.

**Claims 15-16**

Claims 15-16 depend from claim 9. Applicant respectfully submits that Kamm does not remedy the shortcomings of Brimberg as explained above with respect to claim 9. Therefore, claims 15-16 are deemed to be patentable for at least the reasons set forth above with respect to claim 9, and for the following additional reasons.

Among other things, the process of claim 16 includes providing a list of specific plants belonging to each generic plant category.

Neither Brimberg nor Kamm discloses or suggests such a feature, and accordingly no possible combination of Brimberg and Kamm could produce the process of claim 16 that includes such a feature. Indeed, the Office Action fails to even mention this feature, or to allege that it is disclosed by either Brimberg or Kamm.

Accordingly, withdrawal of the rejection of claim 16 is respectfully suggested.

**Claim 18**

Claim 18 was stated to be allowable if rewritten in independent form, including all limitations of its base claim 17. Claim 18 has now been written in independent form, including all limitations of its base claim 17. Accordingly, Applicant respectfully submits that claim 18 is now in condition for allowance.

**NEW CLAIMS 19-20**

New claims 19 and 20 depend respectively from claims 18 and 1 and are patentable for at least the reasons set forth above with respect to claims 18 and 1, respectively, and for the following additional reasons.

The processes of claims 19 and 20 each include: (1) defining a set of generic plant categories according to at least one of the following plant characteristics: plant height, plant diameter, leaf texture, and whether a plant is deciduous or evergreen; and

(2) assigning a set of symbols to the generic plant categories.

Applicant respectfully submits that the prior art, taken individually or collectively, does not disclose or suggest any process including such features.

Accordingly, for at least these additional reasons, Applicant respectfully submits that claims 19 and 20 are patentable.

### CONCLUSION

In view of the foregoing explanations, Applicant respectfully requests that the Examiner reconsider and reexamine the present application, allow claims 1-16 and 18-20, and pass the application to issue. In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact Kenneth D. Springer (Reg. No. 39,843) at (571) 283-0720 to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 50-0238 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17, particularly extension of time fees.

Respectfully submitted,

VOLENTINE FRANCOS & WHITT, P.L.L.C.

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By: \_\_\_\_\_



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